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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,094	04/12/2002	Jun-Ichi Kawakami	2617 USOP	4051

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EXAMINER

MURPHY, JENNIFER C

ART UNIT PAPER NUMBER

1626

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,094

Applicant(s)

KAWAKAMI, JUN-ICHI

Examiner

Jennifer C. Murphy

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 10, 18-34 & 36-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 35 is/are rejected.
- 7) ☐ Claim(s) 1, 5-9 and 11-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-42 are pending in this application. The Office received on 09/20/02, as paper no. 10, the response to the written restriction mailed out by the Office. Applicants have elected group I without traverse.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 35 is objected to under 37 CFR 1.75(c) as being in improper form, as it depends from non-elected subject matter. This objection may be overcome by changing the dependency to correspond with the elected subject matter.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki, et al.

Applicants instantly claim substituted imidazol-4-yl compounds of the general formula (IIIa).

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

The Iwasaki reference discloses substituted imidazol-4-yl compounds of the general formula (II) (see abstract) which generically read on the instant claims when in the instant claims, R' is an unsubstituted alkyl group with 3 or more carbon atoms, either branched or straight.

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**Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The prior art reference does not specifically embody the exact species as those instantly claimed, but generically discloses a generic overlap of possible substituents. The generic teaching by the reference is seen when in the reference, R is  $-\text{COC}(\text{CH}_3)_3$ .

**Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)**

However, it would have been prima facie obvious for one of ordinary skill in the art at the time of filing to make and use additional compounds from under the prior art genus as taught by Iwasaki that were structurally similar to those disclosed in this reference. *In re Schaumann*, 197 USPQ 5.

One of ordinary skill in the art would have been motivated to make compounds mentioned supra because one of ordinary skill in the art would have expected to obtain compounds with same or similar properties, especially when it is known in the art that homologues are not patentably distinct from each other. At the very least, such renders at bar obvious as regards these structured compound(s) and, as regards homologous, isomeric, or other "similar" compounds encompassed in the claims, such are obvious, under 35 U.S.C. § 103 over said reference compounds. In order to establish patentability in adjacent homologs and position isomers, there must at least be a comparative showing establishing distinguishing characteristics allegedly showing that claimed compounds are unobvious. *Ex parte Henkel*, 130 USPQ 474 (1960).

A homologous series is a family of chemically related compounds, the composition of which varies from member to member by one atom of carbon and two atoms of hydrogen, or a  $-\text{CH}_2$  group. *In re Coes, Jr.* (CCPA 1949) 173 F2d 1012, 81 USPQ 369. In the instant claims, applicants claim R' as 3 or more carbons then further claim that R' is a branched alkyl group having 3 or more carbons. It would have been obvious to modify the compounds disclosed in the Iwasaki reference from a tert-butyl group to an alkyl or different type of branched alkyl and therefore, not a patentable distinction, as homologues are obvious variants.

***Allowable Subject Matter***

Claims 1, 5-9 and 11-14 are allowed.

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*Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer C. Murphy, whose telephone number is (703) 305-0159. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

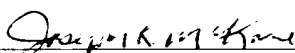
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234.

Jennifer C. Murphy  
October 4, 2002

  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
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